

REMARKS

In the Office Action¹ the Examiner rejected claim 40 under 35 U.S.C. 112, first paragraph and second paragraphs. The Examiner also rejected claims 1-6, 9-36, 40-47 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,536,659 to Hauser et al. ("*Hauser*") in view of U.S. Patent Application Publication No. 2002/0178074 to Bloom ("*Bloom*").

By this amendment, Applicant amends claims 1, 9, 13, 20, 21, 24, 31, 32, 40 and 41. Support for the amendments can be found in the claims as originally filed and in the specification at, for example, paragraph [0056]. Claims 1-6, 9-36 and 40-47 are pending.

Rejections Under 35 U.S.C. § 112

Claim 40 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 40 was also rejected under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. The claim has been amended in response to the rejections. If any further amendments to the claim are necessary, the Examiner is requested to contact Applicant's undersigned representative.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully disputes contentions in the Response to Argument section of the Office Action. On pages 30-31, the Office Action contends that the following claim limitation is "**conditional/optional**" (emphasis added) and, therefore, should be disregarded according to MPEP 2106.II.C:

splitting the second record into a plurality of new records the plurality of new records including the RAN and having different statuses, **when** the quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse (emphasis added)

Applicant respectfully submits that this contention is based on a misreading of the MPEP 2106.II.C. MPEP 2106.II.C does not exclude "**conditional/optional**" (emphasis added) subject matter from consideration. The term "conditional" is not mentioned anywhere in section 2106 of the MPEP, much less in MPEP 2106.II.C. Rather, MPEP 2106.II.C excludes:

Language that **suggests or makes optional but does not require** steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (emphasis added)

MPEP 2106.II.C goes on to list several such examples including: "statements of intended use or field of use," "adapted to" or "adapted for" clauses, "wherein" clauses, or "whereby" clauses. The claimed phrase of "splitting the second record [...] **when** [...]" (emphasis added) **requires** splitting the second record under a specified condition. The claimed phrase simply does **not** "[suggest] or [make] optional" within the meaning of MPEP 2106. The Office Action's contention to this effect is contrary to MPEP 2106.II.C and, therefore, should be withdrawn.

Moreover, Applicant respectfully traverses the rejection of claim 1, insofar as it may be considered to apply to the claim as amended, under 35 U.S.C. §103 as being unpatentable over *Hauser* in view of *Bloom*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)*(internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." *M.P.E.P. § 2141(II)*. In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." *M.P.E.P. § 2141(III)*. Here, no *prima facie* case of obviousness has been established for at least the reason that the scope and content of the prior art have not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained.

Independent claim 1 calls for a combination including, for example "wherein the different statuses indicate return of a quantity of the product." The cited art, alone or in combination, fails to disclose or suggest at least this element of Claim 1.

Bloom discloses a "Method and Apparatus for Efficient Package Delivery and Storage" (title). *Bloom* discloses in paragraph [0185] that "Status [...]" can be used to locate packages in the destination RDC 1180-1." *Bloom* further discloses that package "Status" may be set to values such as "open" (paragraph [0185] of *Bloom*), "destination RDC" (See, e.g., paragraphs [0185] of *Bloom*), "package sort" (paragraph [0185] of *Bloom*) "empty" (paragraph [0185] of *Bloom*), "retailer shipment" (paragraph [0185] of *Bloom*), "pick list back order" (paragraph [0098] of *Bloom*), "retailer shipment-back" (paragraph [0098] of *Bloom*) order," "pick list-back order," "pick list-new," "retailer shipment-new," "retailer shipment-back order" (See paragraphs [0098-99] of *Bloom*), "retailer shipment-new" or "retailer shipment-back order" (See paragraphs [0098-99] of *Bloom*). There is simply no indication in *Bloom* of a status indicating a **"return of a quantity of the product"** (emphasis added), much less **"different statuses indicate return of a quantity of the product"** (emphasis added), as claimed. Therefore, *Bloom* fails to teach, disclose or suggest at least " wherein the different statuses indicate return of a quantity of the product," as recited in newly amended claim 1.

Moreover, although *Hauser* does disclose a "status" in column 2, line 60-65 and column 7, line 33, there is no indication that this "status" "indicate[s] return of a quantity of the product," as claimed in amended claim 1. Rather, as *Hauser* discloses in column 2, lines 66-67, the "status" may be used for "track[ing] the **handling** of the returned merchandise through its final disposition" (emphasis added).

In view of the deficiencies of the prior art set forth above, the Office has neither properly determined the scope and content of the prior art nor ascertained the

differences between the claimed invention and the prior art. Moreover, the Office Action has provided insufficient motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. the rejection of claim 1 under 35 U.S.C. §103 as being obvious from *Hauser* in view of *Bloom*, insofar as it may apply to claim 1 as amended, is thus improper and should be withdrawn. The rejection under 35 U.S.C. §103 of independent claims 9, 13, 20, 21, 24, 31, 32, 40 and 41, insofar as it applies to the claims as amended, should be withdrawn for at least the reasons given above with respect to claim 1 since claims 9, 13, 20, 21, 24, 31, 32, 40 and 41 recite similar elements as above.

Moreover, rejections under 35 U.S.C. §103 of claims depending or ultimately depending from independent claims 1, 9, 13, 20, 21, 24, 31, 32, 40 and 41 are improper and should be withdrawn for at least reasons given above with respect to the independent claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Jackson R. Smith
Reg. No. 61,986
(202) 408-4000